

REMARKS

The Examiner has rejected claims 1-9. Claims 1-17 are presently pending in the application. Claim 1 has been amended. Favorable reconsideration of the application in view of the following remarks is respectfully requested.

The basis for the amendment of claim 1 is page 5 lines 24-25, page 5 lines 29-30, page 6 line 1, and Figure 1. The basis for the foregoing amendment has been found in the specification as originally filed and it is believed that no new subject matter has been added.

Election/Restriction

In response to the Applicant's arguments in traversal of the restriction requirement the Examiner states that the Applicant fails to specifically point out the supposed errors in the Examiner's action, which would include stating why the cutting device is not suitable for non-coating paper. Further, the Examiner states that it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. Finally, the Examiner states that because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes is indicated is proper. The Applicant respectfully transgresses this restriction.

The recited limitations affect the method in a manipulative sense. On page 2 line 30 and page 3 lines 1-3 of the specification, it is stated that the stiffness and toughness properties of the various layers results in uncontrolled crack propagation during cutting and the subsequent formation of hair-like debris. The formation of this hair-like debris results in unacceptable cutting performance. Therefore, the method could not be used with other non-coating paper because the structural limitations of the paper in claims 1-9 affect the cutting performance, and affect the method in a manipulative sense. Therefore, claims 10-17 incorporate the sheet of claims 1-9 in order to produce acceptable cutting results. Under compact examination the inventions should be examined together for effective use of time, as art and the method require overlapping searches.

Therefore, it is respectfully requested that the present restriction be reconsidered and withdrawn.

Claims Rejections -35 U.S.C. §112:

The Examiner indicates that claims 1-9 remain rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Examiner states that the Applicant's argument that the "The usage of the term 'flange' in the present application is consistent with the definition provided by the Examiner" is not persuasive. The Examiner states that the term "flange" in claim 1 is used by the claim to mean "skin", "cover" or "outer", while the accepted meaning is "A protruding rim, edge, rib, or collar, as on a wheel or pipe shaft, used to strengthen an object, hold it in place or attach it to another object." The Examiner points out that the sheet structure of the instantly claimed imaging member bears no resemblance of a wheel or pipe shaft. Therefore, the Examiner states that the term "flange" in claim 1 is vague and indefinite. The Applicant respectfully traverses this rejection.

In the Cambridge Advanced Learner's Dictionary® (© 2003 by Cambridge University Press) a flange is defined as "a flat surface sticking out from an object, which is used to fix it to something or make it stronger." According to this definition, a flange could be attached to a pipe shaft or a wheel, but a flange does not necessarily have to be attached to a pipe shaft or a wheel. Therefore, a flange can be attached to any object, including a foam core sheet.

However, a fundamental principle contained in 35 U.S.C. 112, second paragraph is that Applicants are their own lexicographers. They can define in the claims what they regard as their inventions essentially in whatever terms they choose so long as the terms are not contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim, which makes clear the boundaries of the subject matter for which protection is sought. Applicants need not confine themselves to the terminology used in the prior art, but are required to make clear and precise the terms that are used to define the invention whereby the metes and bounds of the claimed invention can be ascertained. Accordingly,

when there is more than one definition for a term, it is incumbent upon the Applicant to make clear which definition is being relied upon to claim the invention.

In this Application, the diagrams and the description of the invention make clear that the “flange” is attached to an object that is neither a wheel nor a pipe shaft. Since the Applicant’s usage of the term “flange” is not contrary to accepted meaning in the art, and it would have been understood by someone reasonable skilled in the art, the Applicant is entitled to use this term. Furthermore, patents have already issued where the term “flange” is used to indicate “a flat surface sticking out from an object, which is used to fix it to something or make it stronger”. Examples of these patents are U.S. patent No. 6447976, 6537656 and 6514659, copies of which are attached. These patents show that this meaning of “flange” is used in photography, and would be understood by one with ordinary skill in the art. Therefore, it is respectfully requested that the present rejection be reconsidered and withdrawn.

The Examiner further states that the Applicant fails to expressly provide the structural description of “flange layers”. Accordingly, the Applicant has amended claim 1. The basis for this amendment is page 5 lines 24-25, page 5 lines 29-30, page 6 line 1, and Figure 1. Therefore, it is respectfully requested that this rejection be reconsidered and withdrawn.

The Examiner also states that the Applicant’s quoted passage appears to present a fixed core thickness, but nowhere provides express or inherent support that “flange caliper” means flange thickness. As such, the Examiner maintains the term “caliper” in claim 2 is vague and indefinite. In the office action dated July 1, 2003, the Examiner suggests that the Applicant change the term “caliper” to “thickness”. Accordingly, the Applicant has amended the claims so that the term “caliper” has been replaced by the term “thickness”.

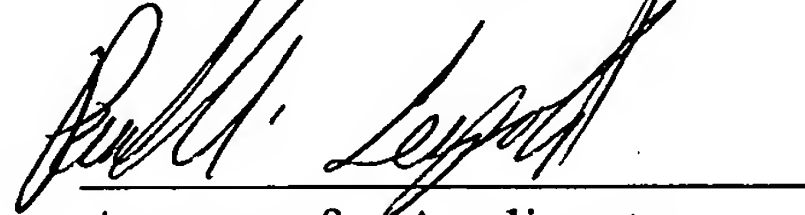
The Examiner states that claim 1 clearly does not recite that the flange layers are adhered to the upper and lower sides of the foam core. The Examiner notes that as such, in an open termed “comprising” clause, both the “upper and lower” flange layers can be on one side of foam core, and the structural relations of the layers are deemed to be vague and indefinite.

Furthermore, the Examiner states that it should be noted that although the claims are interpreted in light of the Specification, limitations from the Specification are not read into the claims. As stated above, the Applicant has amended claim 1 to indicate the location of the flange layers. Therefore, it is respectfully requested that the present rejection be reconsidered and withdrawn.

The Examiner states that that no disclaimer of record has been received. Accordingly, the Applicant has included a terminal disclaimer for U.S. Patent No. 6537656 and 6447976.

It is requested that the above amendment be entered and that this application receive an early Notice of Allowance. In the alternative, it is respectfully requested that the amendments above be entered in order to place the application in better condition for appeal. The amendment above does not raise new issues, since the issues discussed have been previously raised by the Examiner. Therefore no new issues are raised.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Paul A. Leipold", is written over a horizontal line.

Attorney for Applicants
Registration No. 26,664

Paul A. Leipold/rgd
Rochester, NY 14650
Telephone: (585) 722-5023
Facsimile: (585) 477-1148